

## **REMARKS**

### **State of the Claims**

Claims 1-14 are pending. Claims 1-4 have been canceled without prejudice. By canceling Claims 1-4, Applicants are expressly **not** forfeiting the subject matter thereof and expressly reserve the right to later file the subject matter of Claims 1-4 in its originally filed form. Claims 5-14 remain.

### **Claim Objections**

Claims 2 and 4 currently stand objected. The Examiner states that they contain informalities that must be corrected; i.e., the term "permeability" must be added to the term "cellular membrane". Claims 2 and 4 have been canceled without prejudice thus obviating the Examiner's objection.

### **35 U.S.C. § 112 Rejection**

Claims 5-14 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as their invention.

The Examiner states that the term "reduced" in Claims 5 and 12 is a relative term and therefore renders the claims indefinite. The Examiner further states that the term 'reduced' "is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention."

Applicants respectfully disagree with the Examiner's assertions. First, Applicants point out that the claims alone do not have to define the term "reduced". Rather, the specification can provide the proper basis for definition of any term used in the claim. Applicants assert that the specification does in fact provide the proper definition and understanding of the term "reduced" as it relates to acrylamide-reduction.<sup>1</sup>

In addition, common usage of a term can provide definition for claim terms. For example, the term "reduced", in common usage, is defined as "to lessen in extent, amount, number, degree or price." The American Heritage Dictionary, 2<sup>nd</sup> Ed., Houghton Mifflin Company, Boston (1991). Such definition bolsters Applicants' use of the term in their specification since Applicants teach the reduction of the amount of acrylamide in food material in comparison to food material not treated for such acrylamide reduction.

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<sup>1</sup> Applicants' Specification, page 3, lines 12-15: "Accordingly, Applicants have further discovered that acrylamide formation in heated foods can be *reduced* by removing at least a portion of the asparagine before cooking. When such foods containing *reduced* levels of asparagine are heated, the amount of acrylamide formed is reduced. " [Emphasis added.]

Whether one skilled in the art looks to the specification or to common usage, it would be apparent to one skilled in the art that the term “reduced,” as used in the presently rejected claims, means that the level of asparagine/acrylamide is less in treated food material, i.e., food material not exposed to asparagine-reducing enzymes. Thus, the term “reduced” means that the food material has been treated such that the level of asparagine/acrylamide is less than what it would be in untreated food material.

Applicants respectfully assert that one skilled in the art would understand that the use of the term “reduced” in the present claims describes the level of asparagine or acrylamide in treated food material as compared to the level present in untreated food material. Therefore, it is respectfully asserted that the term “reduced” in the presently rejected claims does indeed provide a standard for ascertaining the meaning, such that one skilled in the art would be reasonably apprised of the scope of the claimed invention.

As such, Applicants respectfully request reconsideration and allowance of Claims 5-14 over the Examiner’s 35 U.S.C. § 112, second paragraph, rejection.

#### 35 U.S.C. § 102 Rejection

Claims 1-4 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Sloan (U.S. Patent No. 3,644,129—hereinafter Sloan ‘129). Applicants have canceled Claims 1-4 without prejudice. By canceling Claims 1-4, Applicants are expressly **not** forfeiting the subject matter thereof and expressly reserve the right to later file the subject matter of Claims 1-4 in their originally filed form.

#### 35 U.S.C. § 103 Rejection

Claims 1, 3 and 5-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Elder, et al. (U.S. Patent Application No. 2004/0058054—hereinafter, Elder ‘054). Claims 1 and 3 have been canceled without prejudice. Claims 5-14 remain. By canceling Claims 1 and 3, Applicants are expressly **not** forfeiting the subject matter thereof and expressly reserve the right to later file the subject matter of Claims 1 and 3 in their originally filed form.

The Examiner states that Elder ‘054 discloses a method for reducing the amount of acrylamide in thermally processed foods. The Examiner further states that Elder’s direct teaching and guidance would lead to one of skill in the art to have leached or extracted asparagine from food products known to have elevated acrylamide formation by any of various means known in the art.

The Examiner bears the burden of factually supporting any prima facie conclusion of obviousness. In determining the differences between the cited art and the claims, the question is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. See Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530 (Fe. Cir. 1983).

Distilling the invention down to the “gist” or “thrust” of an invention disregards the requirement of analyzing the subject matter “as a whole.” See W.L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540 (Fed. Cir. 1983). Inventors of unobvious compositions, such as those of the present invention, enjoy a *presumption* of non-obviousness, which must then be overcome by the Examiner establishing a case of *prima facie* obviousness by the appropriate standard. If the Examiner does not prove a *prima facie* case of unpatentability, then without more, the Applicant is entitled to grant of the patent. See In re Oetiker, 977 F.2d 1443.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all of the claim limitations.<sup>2</sup>

Regarding Claims 5-14, the Examiner states that it would have been obvious to one of ordinary skill in the art to have packaged and appropriately labeled the food products produced by Elder ‘054. Such packaging techniques, notes the Examiner, were well known in the art.

Applicants respectfully disagree with the Examiner's assertions. Applicants’ respectfully assert that the Examiner is using the wrong test for obviousness. The test is whether the reference itself, herein Elder ‘054, or knowledge generally available to one of skill in the art teaches or suggests Applicants’ invention. Applicants assert that neither condition has been met.

First, nothing in Elder ‘054 teaches or suggests an article of commerce that communicates the reduction or lowness of acrylamide in Applicants’ food material. Elder ‘054 does not itself teach the reduction of acrylamide in food but merely a reaction of an enzyme with asparagine and simple sugar in a test vial.

Second, Applicants assert that one of skill in the art would not have been led to produce an article of commerce that communicates the reduction of acrylamide in food. Heretofore, the ability to reduce acrylamide in edible structures producing asparagine has never been accomplished until Applicants accomplished this reduction. Thus, there was no knowledge generally held available to one of skill in the art that such a claim, i.e., the reduction or lowness of acrylamide in food, was possible or even desired. Applicants point out that they claim an article of commerce having a message informing a consumer that the product has a reduced level of acrylamide. Applicants are not claiming a generic message or merely words on a package which is within the knowledge of one of ordinary skill in the art. Rather, Applicants’ message is specific to a heretofore unobtainable function by any one of skill in the

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<sup>2</sup> In re Vaeck, 947 F. 2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

art save Applicants. Such a message is therefore not within the knowledge of one of ordinary skill in the art.

Thus, Applicants respectfully request reconsideration and allowance of Claims 5-14 over the Examiner's 35 U.S.C. § 103(a) rejection in view of Elder '054.

Double Patenting - Non-Statutory

Claims 5-14 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-50 of co-pending Application No. 10/606,260.

Applicants respectfully traverse these rejections. Applicants submit that the Examiner has failed to provide sufficient basis for asserting that the cited claims of U.S. Patent Application No. 10/606,260 teach or suggest the claims of the present application which are directed to reducing asparagines or acrylamide in food. Accordingly, it is respectfully requested that the obviousness-type double patenting rejections be withdrawn.

Claims 1-4 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 6 of co-pending Application No. 10/606,137. Applicants respectfully traverse this rejection. Applicants submit that the Examiner has failed to provide sufficient basis for asserting that the cited claims of U.S. Patent Application No. 10/606,137 teach or suggest the claims of the present application which are directed to reducing asparagine or acrylamide in food. Accordingly, it is respectfully requested that the obviousness-type double patenting rejections be withdrawn.

Claims 1-4 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claim 6 of co-pending Application No. 10/603,279.

Applicants respectfully traverse these rejections. Applicants submit that the Examiner has failed to provide sufficient basis for asserting that the cited claims of U.S. Patent Application No. 10/603,279 teach or suggest the claims of the present application which are directed to reducing asparagines or acrylamide in food. Accordingly, it is respectfully requested that the obviousness-type double patenting rejections be withdrawn.

Claims 1-4 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claim 10 of co-pending Application No. 10/603,973.

Applicants respectfully traverse these rejections. Applicants submit that the Examiner has failed to provide sufficient basis for asserting that the cited claims of U.S. Patent Application No. 10/603,973 teach or suggest the claims of the present application which are directed to reducing asparagines or acrylamide in food. Accordingly, it is respectfully requested that the obviousness-type double patenting rejections be withdrawn.

Claims 1-4 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claim 1 of co-pending Application No. 10/603,278.

Applicants respectfully traverse these rejections. Applicants submit that the Examiner has failed to provide sufficient basis for asserting that the cited claims of U.S. Patent Application No. 10/603,278 teach or suggest the claims of the present application which are directed to reducing asparagines or acrylamide in food. Accordingly, it is respectfully requested that the obviousness-type double patenting rejections be withdrawn.

Claims 5-14 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 13-14 of co-pending Application No. 10/603,978.

Applicants respectfully traverse these rejections. Applicants submit that the Examiner has failed to provide sufficient basis for asserting that the cited claims of U.S. Patent Application No. 10/603,978 teach or suggest the claims of the present application which are directed to reducing asparagines or acrylamide in food. Accordingly, it is respectfully requested that the obviousness-type double patenting rejections be withdrawn.

**SUMMARY**

The rejections in the Office Action have been discussed and, Applicants believe, the proper discussions and/or amendments have been set forth to address the rejection.

In light of both the amendments and the discussions contained herein, Applicants respectfully request reconsideration of the rejection and its withdrawal.

Issuance of a Notice of Allowance at an early date is earnestly solicited.

Respectfully submitted,

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